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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,147	07/08/2003	David W. Abraham	YOR920010260US2	8233

7590 03/11/2004

Dr. Daniel P. Morris, Esq.  
IBM Corporation  
Intellectual Property Law Dept.  
P.O. Box 218  
Yorktown Heights, NY 10598

EXAMINER

LE, THONG QUOC

ART UNIT	PAPER NUMBER
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2818

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/615,147

Applicant(s)

ABRAHAM ET AL.

Examiner

Thong Q. Le

Art Unit

2818

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

THONG LE

PRIMARY EXAMINER  
Part of Paper No./Mail Date 2

**DETAILED ACTION**

1. Pre-amendment filed on July 08, 2003 has been entered.
2. Claims 1-60 are presented for examination.

***Response to Amendment***

3. Regarding to REMARKS section, applicant provides a U.S. Pub. Applicant application of number 2002/0089874 A1 has claims having inventions are the same with present application. However, they are not the same inventions as such as applicant declared in REMARKS section.

**REMARKS**

Claims 1-60 are substantially the same as the claims of US published application 2002/0089874 A1.

Please charge deposit account 09-0468 any fee necessary to enter this amendment.

Respectfully submitted,

By: 

Dr. Daniel P. Morris, Esq.  
Reg. No. 32,953  
Phone No. (914) 945-3217

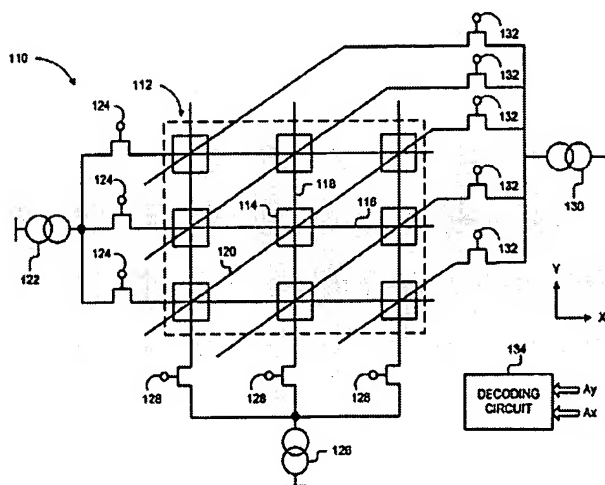
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US 20020089874A1

(19) **United States**(12) **Patent Application Publication** (10) Pub. No.: **US 2002/0089874 A1**

Nickel et al.

(43) Pub. Date: **Jul. 11, 2002**(54) **THERMALLY-ASSISTED SWITCHING OF  
MAGNETIC MEMORY ELEMENTS**(22) Filed: **Jan. 11, 2001****Publication Classification**(76) Inventors: Janice H. Nickel, Sunnyvale, CA (US);  
Lung T. Tran, Saratoga, CA (US)(51) Int. Cl.<sup>7</sup> **G11C 11/15**  
(52) U.S. Cl. **365/171**Correspondence Address:  
**HEWLETT-PACKARD COMPANY**  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80528-9599 (US)(57) **ABSTRACT**A magnetic memory element is written to by heating the  
memory element and applying at least one magnetic field to  
the memory element.(21) Appl. No.: **09/758,757**

4. As shown above, examiner could not find the relationship between two applications.

### ***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Double Patenting***

6. Claims 1-40 of this application conflict with claims 1-20 of Application No. 10/128,838. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 21-40 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-20. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

9. Claims 1-40 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 10/128,838. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

As details provided above, the claims 1-40 should be amended or canceled as required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 41-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Urner Wille et al. (U.S. Patent No. 4,464,437).

Regarding claims 41-60, Urner Wille et al. disclose a method of writing to a magnetic memory element (Column 3, lines 39-48), the method comprising: heating the memory element; and applying at least one magnetic field to the memory element (Column 1, lines 22-42, Column 3, lines 39-54), and wherein the heat and at least one magnetic field are applied to the memory element simultaneously (Column 1, lines 30-32), and

Art Unit: 2818

wherein heat is applied and removed before at least one magnetic field is applied to the memory element (Column 4, lines 29-41), and wherein the heating raises the temperature of the memory element by about 5 C0 to 10 C0 above a compensation temperature (Column 1, lines 39-52), and wherein the heating raises the temperature of the memory element (Column 1, lines 39-52), and wherein the junction is heated by passing a current through a conductor (Column 3, lines 49-54), and wherein first and second orthogonal fields (Figure 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Le whose telephone number is 571-272-1783. The examiner can normally be reached on 8:00am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David C. Nelms can be reached on 571-272-1787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Le  
Primary Examiner  
Art Unit 2818

**THONG Q. LE**  
**PRIMARY EXAMINER**